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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL BILIBIN and JINYUE LIU

Appeal 2008-005469
Application 09/684,861
Technology Center 3600

Decided: November 30, 2009

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*, ANTON W. FETTING, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-13, 15-17 and 19-23. Claims 14 and 18 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). (2002)

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a computer system and method for obtaining parcel shipping information and presenting same as a potential cross-comparison delivery schedule comprising a respective delivery date and a respective delivery time for respective delivery services (Specification 2:30 - 3:3).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A shipping management computer system, said computer system programmed to:
in response to each respective request by each respective particular user of a plurality of users to ship a particular respective parcel, wherein each respective request comprises a first address and a second address, *determine a respective potential cross- comparison delivery schedule*, said respective cross-comparison delivery schedule comprising a plurality of respective service-specific, carrier-specific delivery schedules to ship the particular respective parcel from the first address to the second address, wherein each respective service-specific, carrier-specific delivery schedule corresponds to a respective particular delivery service of a plurality of delivery services offered by a respective particular carrier of a plurality of carriers, wherein the respective potential cross-comparison delivery schedule comprises a respective delivery date and a respective delivery time for each respective particular delivery service of the plurality of delivery services offered by each respective particular carrier of the plurality of carriers that would deliver the particular respective parcel, and wherein the shipping management computer system is accessed by each

respective particular user via a communications network using a respective user client computer device. (Emphasis added).

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Thiel	5,699,258	Dec. 16, 1997
Fed Ex (www.fedex.com)		

The following rejection is before us for review.

The Examiner rejected claims 1-13, 15-17, and 19-23¹ under 35 U.S.C. § 103(a) as being unpatentable over Thiel in view of FedEx.

ISSUES

Have Appellants shown that the Examiner erred in rejecting claims 1-13, 15-17, and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over Thiel in view of FedEx on the grounds that a person with ordinary skill in the art would understand that: 1) the rules-based schedule of FedEx could be automated to calculate a comparison delivery schedule comprising a respective delivery date and a respective delivery time for each respective particular delivery service; and 2) that the definition of the term “schedule” would include the comparison table in Thiel because one of the required data

¹ Although claims 22 and 23 are not listed by the Examiner in the heading of the 35 U.S.C. § 103(a) rejection of the December 20, 2005 Final Office Action, it is clear from the remainder of that Action that claims 22 and 23 were meant to be included because they are listed on the cover sheet as pending, rejected and addressed on the merits by the Examiner on pages 10-11 of the Final Office Action and in the Answer on page 12.

to be entered as part of the information needed for generating the comparison table is the proposed date of mailing of the item ?

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Appellants' Specification does not specifically define the term "schedule," nor does it utilize the term contrary to its customary meaning.
2. The ordinary and customary definition of "schedule" is: "A time-based plan of events." Wiktionary, <http://en.wiktionary.org/wiki/schedule> (last visited Nov. 23, 2009).
3. Appellants' Specification, in the Background of the Invention section, only discusses the term "schedule" as a mode of operation, rather than providing an explicit definition of the term, stating:

One of the problems in dealing with standalone Carrier systems is that the Shipper must attempt to apply each Carrier's delivery schedule rules to a particular parcel in order to compare rates for various potential delivery schedules of the parcel. Each Carrier's delivery schedule rules and associated pricing rules must be separately applied by the Shipper to a particular parcel's specifications and an origin and a destination zip code in order to preview each Carrier's potential delivery schedule and rates for shipping a particular parcel.

(Specification 2:19-24).

4. The Examiner found that: "...while Thiel discloses the date of shipping and planning delivery based on the shipment type, such as express

mail, Thiel does not expressly disclose that the delivery schedule comprises a respective delivery date and a respective delivery time for each respective particular delivery.” (Answer 5).

5. The Examiner thus found that “FedEx discloses a carrier offering shipment types wherein shipment types comprise a respective delivery date and a respective delivery time (See pages 2-3, page 5, section 1, and page 6, which disclose the different service types offered along with a delivery date and time associated with the delivery).” (Answer 5).

6. The Examiner concluded that the combination of Thiel and FedEx would be obvious because:

Thiel discloses that [the] date of the shipment is input into the system and also discloses shipment types for carriers, these shipment types including express mail, priority, etc. FedEx discloses a respective delivery date and a respective delivery time for each service type for the carrier, such as if the current date was 12/12/05, the shipment type “priority overnight” would give the delivery date of 12/13/05 with the delivery time of 10:30.

Therefore, since Thiel discloses specifying a date of shipment in the system and types of services that include guaranteed times to delivery, it would have been obvious to one of ordinary skill in the art at the time of the invention to include displaying the delivery date and delivery time of the carrier, such as the dates and times set forth in FedEx, in order to increase user satisfaction with shipping items by showing a display containing more comprehensive information about the service types offered by the competing carriers, thus

aiding the user in the selection of a proper carrier.
See column 10, lines 55-67, and column 11, lines
45-55, of Thiel.

(Answer 5-6).

7. Thiel discloses that:

The franking machine must store the services and the fees of the various carriers in a comparable form. The following table is exemplary of such a comparison:

	Carrier 1	Carrier 2	Carrier 3	Carrier 4	Carrier 5
Destination Zone	A	B	A + B	A	A + B + C
Base Charge (B)	.32	.50	.70	.75	1.05
Express Delivery	-	-	+	+	+
Added Charge (B)	-	-	.40	.30	0.00
Return Receipt	-	-	-	-	-
Added Charge (R)	-	2.10	1.90	-	2.80
Discount (D)					
>100 items	.06	--	--	--	.10
>1000 items	.14	.18	.11	--	.18
>10000 items	.25	.25	.25	.40	.30

(Thiel, col.10, ll.65-66; col.11, ll.1-14).

8. Thiel further discloses fee calculation by a carrier in that:

The user of the franking machine first defines the required services. This is done by entering the data with regard to the ship-to zone (the destination zone) and the desired additional services such as express delivery (E), return receipt (R), etc. An additionally required entry would be the number of items to be shipped, so as to take advantage of the discounts available for volume mailing. In a first selection process, a

mask (a first step selection) searches the carriers which offer the desired services. For example, shipping to zone B and asking for a return receipt excludes carriers 1, 2 and 4 in accordance with the table above, and the further selection process is limited to carriers 3 and 5 only.

(Thiel, col.11, ll. 15-26).

9. Thiel discloses that following the selection of carrier(s) which offer the desired services, the system then performs a fee optimization to obtain a best price calculation taking into account the base fee (B), the special service fees, the return receipt fee, and discounts. (Thiel, col.11, ll. 26-29).

10. Thiel further discloses summing and then comparing the fees of various carriers so as to automatically suggest the optimal carrier. (Thiel, col.11, ll. 36-38).

11. FedEx discloses a rules-based delivery schedule as follows:

FedEx SameDay®

Urgent shipments can arrive within the U.S. the same day you call, 7 days a week, 365 days a year, depending on availability. Call 1-800-Go-FedEx (800-463-3339) to book your shipment. A courier will bring you an airbill to complete.

- Maximum weight: 70 lbs.
- Up to 48" in length, 90" in length and girth combined

FedEx First Overnight®

Delivery of critical shipments by 8 a.m. the next business day to 90 major U.S. markets.

- Available from any U.S. origin (except Hawaii) to nearly 5,000 U.S. ZIP codes

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- Maximum weight: 150 lbs.

FedEx Priority Overnight®

Delivery by 10:30 a.m. the next business day to thousands of U.S. cities; by noon to most other areas; and by 4:30 p.m. to remote locations

- Maximum weight: 150 lbs.
- Up to 119" length, and 165" in length and girth combined
- Pickup and delivery Monday-Saturday

FedEx Standard Overnight®

Next-business-day delivery by 3 p.m. to thousands of U.S. cities; by 4:30 p.m. to many other areas

- Maximum weight: 150 lbs.
- Up to 119" length, and 165" in length and girth combined
- Pickup and delivery Monday-Friday; only pickup is available on Saturday

FedEx 2Day®

Economical option for delivery within 2 business days by 4:30 p.m. to most areas within the U.S.; by 7 p.m. for residential deliveries

- Maximum weight: 150 lbs.
- Up to 119" length, and 165" in length and girth combined
- Pickup and delivery Monday-Saturday

FedEx Express Saver®

New service provides cost-effective delivery in 3 business days by 4:30 p.m. within the continental U.S. (For residential destinations, shipments are delivered by 7 p.m., a \$1 special handling fee may apply, and we may not obtain a signature).

- Maximum weight: 150 lbs.
- Up to 119" length, and 165" in length and girth combined
- Pickup and delivery Monday-Friday; only pickup is available on Saturday.

FedEx, pp.2-3.

12. The Examiner found that Thiel discloses a cross comparison delivery schedule in the Table listed *supra* (FF 7) in that "...the comparison table ...lists different carriers and compares items associated with the carriers, such as express delivery and prices." (Answer 14).

13. Thiel discloses that the required data to be entered as part of the information data for shipping is the proposed date of mailing of the item, the place mailed and the destination address, which are entered into the device to effect the resulting comparison shown in the Table (FF 7). (Thiel, col.10, ll. 45-56; fig. 5)

14. Thiel discloses that postal rate tables are stored in memory such that:

The zones, which are associated with distances and/or assigned to domestic vs. foreign locations, or the distance from the place of origin to the receiving location may be stored in memory as a supplementary function in such a way that it can be called up and ascertained in a further memory region A, B, C, etc., for each country, and the appropriate zone in the current table is addressed by the control means (FIGS. 3a-3c).

(Thiel, col. 8, ll. 50-58).

15. The Examiner found that Thiel discloses an “architecture of the system, which includes downloading tables, a communications network, and a client device (i.e. the franking machine). Therefore, the device of Thiel downloads information such as via a communications network.” (Answer 15-16).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

ANALYSIS

We affirm the rejection of claims 1-13, 15-17, and 19-23 under 35 U.S.C. § 103(a) as being unpatentable over Thiel in view of FedEx.

Argument 1:

With respect to Argument 1, initially, we note that Appellants argue claims 1-13, 15-17, and 19-23 together as a group. Correspondingly, we select representative claim 1 to decide the appeal of these claims, with the remaining claims standing or falling with claim 1.

Appellants argue that “*Thiel* does not disclose determination or display of any schedule.” (Appeal Br. 16). The argument is not well taken because the Examiner acknowledges that Thiel does not disclose the schedule feature (FF 4), but rather found that the schedule aspect of the claimed subject matter is disclosed by FedEx (FF 5).

Appellants next argue that “The *FedEx* reference amounts to nothing more than a general description of various services offered by FedEx® and rules that FedEx® applies to shipments.” (Appeal Br. 16). We disagree with Appellants because these rules are properly founded in fact by the Examiner (FF 5) to be scheduling rules which identify a respective delivery date and time, e.g., next-business-day delivery by 3 p.m. (FF 11), as required by the claims. If the Appellants’ argument is that the FedEx reference fails to explicitly state that these rules are actually used (“there is no disclosure of a determination of a schedule or a calculation of shipping costs for a particular parcel” (Appeal Br. 17), we find that the very nature of FedEx as a shipping carrier makes such usage necessary and inevitable to simply carry out its business operations. It would be impossible to bill a customer and

earn revenue without executing the rules that spell out how fares are computed.

Appellants, in their pre-*KSR* Brief, next argue that “...it is respectfully submitted that there is no disclosure, teaching or suggestion in either *FedEx* or *Thiel* to combine the mere listing and explanation of delivery services in *FedEx* with the postal franking device, system and method of *Thiel*.¹⁰

(Appeal Br. 17). To the extent Appellants seek an explicit suggestion or motivation in the reference itself, this is no longer the law in view of the Supreme Court’s recent holding in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). Since the Examiner has provided some articulated reasoning with some rational underpinning for why a person with ordinary skill in the art would modify Thiel to include the delivery date and time of the involved carrier (FF 6), Appellants’ argument is not persuasive as to error in the rejection. This is because we find it reasonable to accept the Examiner’s finding that user satisfaction would be increased by displaying to the user more comprehensive information about the involved carrier(s), as evidenced by the success of the practice of a competing carrier, such as FedEx (FF 6).

Argument 1a: independent claims 1, 4, and 7; dependent claims 17, 22, 23

With respect to Argument 1a, initially, we note that the Appellants argue claims 1, 4, 7, 17, 22, and 23 together as a group. Correspondingly, we select representative claim 1 to decide the appeal of these claims, with the remaining claims standing or falling with claim 1.

Appellants argue that:

The specification of the present patent application explains that the term "delivery schedule" as used in the Claims pertains to a schedule determined according to, among other things, each Carrier's delivery schedule rules as applied to a particular parcel's specifications and an origin and a destination zip code. *See, e.g., Specification, p. 2, lines 19-26.*

(Appeal Br. 19).

The Examiner however found that Thiel discloses a cross comparison delivery schedule in the Table listed *supra* (FF 7) in that "...the comparison table ...lists different carriers and compares items associated with the carriers, such as express delivery and prices." (FF 12).

We agree with the Examiner. The Appellants' Specification does not specifically define the term "schedule," nor does it utilize the term contrary to its customary meaning (FF 1). The excerpt which Appellants cite to in their Brief seeking an explicit interpretation of the term "delivery schedule" only discusses the term "schedule" as a mode of operation, rather than providing an explicit definition (FF 3). Thus, we adopt the ordinary and customary definition of "schedule" which we find to be: "[a] time-based plan of events." (FF 2).

Using the ordinary and customary definition of the term "schedule", we find that the comparison table (FF 7) in Thiel is a schedule because Thiel discloses that at least one of the data entered as part of the required shipping information data is the proposed date of mailing of the item (FF 13). Thus,

we find that because the comparison uses a date to generate a comparison schedule, it is time-based and thus meets the definition of a schedule.

Appellants next argue that “a stored table such as the stored *Thiel* table, is not determined ‘... in response to each respective request by each respective particular user of a plurality of users to ship a particular respective parcel, wherein each respective request comprises a first address and a second address ...’ as recited by independent Claims 1, 4 and 7.” (Appeal Br. 20). We disagree with Appellants because Thiel discloses that this data is stored “as a supplementary function in such a way that it can be called up and ascertained in a further memory region A, B, C, etc., for each country, and the appropriate zone....” (FF 14). Thus, like that of Appellants, generating the comparison table in Thiel is also done in response to a user request in which a proposed date of mailing, place mailed and destination address must first be entered to generate a table which responds to that specific request data (FF 8, 13, 14).

Appellants next argue that “... the stored *Thiel* table is used to perform a mask search *after* the user has already ‘defined the required services.’” (Appeal Br. 20). We disagree with Appellants because there is nothing in claim 1 which requires the recited steps to be carried out in any given order as so argued.

Appellants also assert that in Fed Ex, “... in order for a delivery *date* to be determined, a user of *FedEx* would need to consult a calendar (mentally or visually) to determine the delivery date on which a parcel

shipped via, e.g., FedEx Standard Overnight® should be delivered.” (Appeal Br. 22).

We disagree with Appellants that this point distinguishes over the prior art. The Examiner found that FedEx discloses different service types offered along with a delivery date and time associated with the delivery. (FF 5). Although the FedEx schedule displays the duration of the time in transit rather than the calculated end date, e.g. FedEx three (3) day delivery, we nevertheless find that a person with ordinary skill in the art would know to automate the calculating step to determine the expected delivery date and to use the rules of delivery to result in a schedule which includes the calculated end dates. *See Leapfrog Enters., Inc. v. Fisher Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (“[O]ne of ordinary skill in the art . . . would have found it obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost.”).

Appellants also argue that “...Thiel does not disclose that ‘... the shipping management computer system is accessed by each respective particular user via a communications network using a respective user client computer device’” (Appeal Br. 24).

The Examiner however found that Thiel discloses an “architecture of the system, which includes downloading tables, a communications network,

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and a client device (i.e. the franking machine). Therefore, the device of Thiel downloads information such as via a communications network.” (FF 15).

Appellants in turn argue that such receivers communicate with a network only for the purpose of downloading data tables. (Appeal Br. 24).

We disagree with Appellants because Appellants’ arguments are not commensurate with the broader scope of claim 1 which merely recites that the management computer system is accessed by each respective particular user without respect to what type of information is accessed. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Argument Ib: claims 2, 5, 8 and 15

Representative claim 2 recites *calculate[ing] a respective shipping rate for each said respective particular delivery service to ship the particular respective parcel according to the respective service-specific, carrier-specific delivery schedule.*

Appellants argue that the user in Thiel:

would have to select a first desired delivery service, such as, e.g., Express Delivery, and instruct the Thiel system to calculate rates for that first desired delivery service across all of the Thiel-served carriers. The Thiel user would then have to select a second desired delivery service, such as, e.g., delivery without Express Delivery, and instruct the Thiel system to calculate rates for that second desired delivery service across all of the Thiel-served carriers.

(Appeal Br. 26).

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We disagree with Appellants because again there is nothing in claim 2 which requires the calculation to be done in a single step as argued above. Second, Thiel explicitly discloses summing and then comparing the fees of various carriers to automatically suggest the optimal carrier (FF 9, 10), which we find meets the claimed rate calculating requirement.

Argument 1c: claims 3, 6, 9 and 16

Appellants' arguments as to the claims in this group rest on those arguments advanced above for claims 2, 5, 8 and 15 (Appeal Br. 27) which we found unpersuasive. Accordingly, we also sustain the rejection of claims 3, 6, 9 and 16.

Argument 1d: independent claim 10 and dependent claims 11, 12, 13, 20 and 21.

Appellants' arguments as to the claims in this group rest on those arguments advanced above for claims 1, 4, and 7 (Appeal Br. 28) which we found unpersuasive. Accordingly, we also sustain the rejection of claims 10, 11, 12, 13, 20 and 21.

Argument 1e: Claims 19, 20, and 21

Appellants' arguments as to the claims in this group rest on those arguments advanced above for claims 1, 4, and 7 (Appeal Br. 29) which we found unpersuasive. Accordingly, we also sustain the rejection of claims 19, 20, and 21.

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CONCLUSION

Appellants have not shown that the Examiner erred in rejecting claims 1-13, 15-17, and 19-23 under 35 U.S.C. § 103(a) as being unpatentable over Thiel in view of FedEx.

DECISION

The decision of the Examiner to reject claims 1-13, 15-17, and 19-23 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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